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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10 082,083	02-26-2002	Toshiki Taru	50212-351	8602

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MCDERMOTT WILL & EMERY
600 13TH STREET, N.W.
WASHINGTON, DC 20005-3096

EXAMINER

DOAN, JENNIFER

ART UNIT	PAPER NUMBER
2874	

DATE MAILED: 05/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/082,083

Applicant(s)

TARU ET AL.

Examiner

Jennifer Doan

Art Unit

2874

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133) and earn patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 11 March 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-5 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.

- 4) Interview Summary (PTO-413) Paper No(s) _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

2. Applicants' cooperation is requested in correcting any errors of which applicants may become aware in the specification.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dong et al. (U.S. Patent 6,009,222).

Dong et al. disclose (Figs. 1a and 1b) an optical fiber (10) comprising a core region (20) having a first refractive index with a UV photosensitivity (column 4, lines 31-44); an inner cladding region (30) surrounding the core region (20) and having a second refractive index lower than the first refractive index with a UV photosensitivity (column 4, lines 33-65) and an outer cladding region (40) surrounding the inner cladding region (30) and having a third refractive index lower than the first refractive index (column 4, lines 36-41); wherein the average value of UV photosensitivity in the core region is different from that of the inner cladding region (column 6, lines 40-48 and column 10, lines 13-20) and further wherein the optical fiber having a refractive index modulation formed in a predetermined area along a longitudinal direction of that as shown in Figs. 1a, 1b and 2.

Dong et al. disclose all the limitations of the claimed invention except for the deviation of UV photosensitivity over of the core region and the inner cladding region $\pm 10\%$ or less as recited in claims 1-3. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the deviation of UV photosensitivity over of the core region and the inner cladding region

±10% or less, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Dong et al. disclose all the limitations of the claimed invention except for the deviation of UV photosensitivity over of the core region and the inner cladding region ±5% or less as recited in claim 4. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the deviation of UV photosensitivity over of the core region and the inner cladding region ±5% or less, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Response to Arguments

6. Applicants' arguments filed 03/11/2003 have been fully considered but they are not persuasive. Because:

A/ The Examiner does not agree with the applicants' arguments that Dong et al. do not teach "the UV photosensitivity in the inner cladding region has a deviation of ±10% or less as recited in claims 1-3 and/or ±5% or less as recited in claim 4" (the explanations for these limitations are on pages 13 and 14 in the specification of the present invention: "the cladding mode coupling loss is reduced to about 0.1 dB where the difference between the average values of UV photosensitivity in core region and inner cladding region"). In fact, Dong reference explicitly teach these limitations in column 7, lines 12-32.

B/ In the remarks, applicants argue that Dong et al. specifically teach "the photosensitive region of the inner cladding preferably has a higher photosensitivity than that of the core region which is opposed to that of the present invention and claims" (on page 4 in the remarks). The Examiner does not agree with this argument because the claims only recite "a deviation or difference of the UV photosensitivity between the core and the cladding regions", they do not recite which one is higher.

Therefore, the rejections based upon the prior art made of record in the previous Office Action are still maintained. This action is made final.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

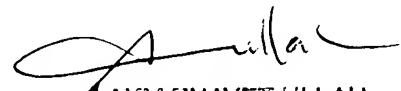
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Mizrahi et al. (Journal of Lightwave technology) disclose optical properties of Photosensitive fiber Phase gratings.

9. Any inquiry concerning the merits of this communication should be directed to Examiner Jennifer Doan whose telephone number is (703) 308-6179. The examiner can normally be reached on Monday to Friday from 6:30 am to 4:00pm, first Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rodney Bovernick, can be reached on (703) 308-4819. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7724.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



AKHMED ENAYET ULLAH
PRIMARY EXAMINER

JD

JD

May 14, 2003